



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/296,676	04/22/1999	DEVON DAVID CULLUM	2146-6	8733

7590 04/02/2003

NIXON & VANDERHYE PC
8TH FLOOR
1100 NORTH GLEBE ROAD
ARLINGTON, VA 222014714

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT	PAPER NUMBER
----------	--------------

2635

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/296,676

Applicant(s)

CULLUM, DEVON DAVID

Examiner

Brian A Zimmerman

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

EXAMINER'S RESPONSE

Status of Application

In response to the applicant's amendment received on 1/13/03. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-25 are unpatentable for the reasons set forth in this office action:

This case was previously assigned to M. Nguyen, but has been reassigned to Brian Zimmerman.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claim 1-4, 6-9, 11-15, and 21-25 rejected under 35 U.S.C. 102(e) as being anticipated by Isikoff US 5,748,084.

Referring to claim 1, Isikoff in the same field of endeavor disclose an anti-theft device operable with an electronic apparatus100, the device comprising a remote

Art Unit: 2635

intelligent communication (RIC) unit contained within a casing of the electronic apparatus and including structure that enables tracking of the electronic apparatus (col. 3, line 55-61, Fig. 2). Isikoff further discloses the RIC unit operable to receive a signal transmitted from an interrogator 110 (Fig. 1). Isikoff further discloses that the beacon may be made as a removable assembly; this is interpreted that the beacon may be made separate from the utilization circuitry for normal operations of electronic apparatus it is attached to. Col. 4 lines 35-38.

Isikoff inherently disclose the device (beacon) determines whether the signal is intended for the anti-theft device and whether the signal includes a shut-off command and, if so, to produce a shut-off signal in response (col. 5, line 20 – col. 6, line 15, the signal as the incoming data are interpreted by the beacon and passing the data to computer which causes disabling of power to all or specific parts of the computer).

Isikoff further disclose the beacon as a shut-off unit couple to a power source of the electronics apparatus, the shut off unit in a shut-off state preventing a flow of electricity via the power source in accordance with the shut-off signal (col. 4, line 14-34, the beacon control a switch to cut power to the computer 100 or various subsections).

Referring to claim 2, Isikoff disclose the beacon is also a reset device communicating with the shut-off unit including a controller 30 communicating with memory 40 and an input device 20 (receiving signal from interrogator), wherein the controller keeps the computer system in the shut-off state until a predetermined data (reset or enable) corresponding to the electronic apparatus data is entered (col. 4, line 62, - col. 5, line 11).

Referring to claim 3, Isikoff inherently discloses the device comprising a code reset device, the shut-off unit remaining in the shut-off state until a predetermined code is input to the reset device (col. 4, line 3-, the beacon shuts the computer down when it has not received an authorization call via cellular network).

Referring to claim 4, Isikoff disclose the device comprising a message activating unit communicating with the RIC unit, the message activating unit activating a message in accordance with the shut-off signal (col. 5, line 34-44, the computer having a software interface provides an visual indication the computer system has been disable because the system was reported stolen).

Referring to claims 6-9, it is noted that claims 6-9 claim the same elements as claim 1-4. Therefore, claims 6-9 are rejected for the same reasons with respect to claim 1-4.

Referring to claim 11, it is noted that claim 11 repeatedly claims elements as claim 1. Furthermore, Isikoff disclose the device having a transceiver 10 coupled to the control circuit (beacon) (Fig. 3).

Referring to claims 12 and 13, Isikoff disclose the communication unit comprising a transmitter 10 (transceiver) and control circuit 45 produces a return signal that is transmitted to the interrogator via transmitter 10 to provide tracking data for the electronic apparatus (Abstract). Isikoff further discloses the data comprising location coordinates derived from a GPS (col. 10, line 11-31).

Referring to claim 14, Isikoff inherently discloses the communication unit wherein the transmitter and control circuit produce a return signal that is transmitted to the interrogator via the transmitter to acknowledge receipt of the signal including the

Art Unit: 2635

electronic apparatus shut-off command (col. 2, line 46-66 and col. 5, line 35-44, the anti-theft device provides two-way RF communication and the beacon response the current status of computer).

Referring to claim 15, it is noted that claim 15 repeatedly claims elements as claim 2. Furthermore, Isikoff implies or suggests the control circuit compares input data supplies to the anti-theft device with the data stored in memory (col. 4, line 62 – col. 5, line 11, the signal received has to be authorized).

Referring to claim 21 and 22, Isikoff discloses the signal is transmitted from the interrogator via a satellite link or a cellular telephone link (col. 10, line 60-65).

Referring to claim 23, Isikoff discloses the electronic apparatus is a consumer electronic device (col. 1, line 48-53).

Referring to claim 24, Isikoff discloses the power blocking circuit is included within a packaged integrated circuit chip including other circuitry used by utilization circuitry of the electronic apparatus (col. 4, line 35-38).

Referring to claim 25, Isikoff disclose the communication unit further comprising a programmable timer for periodically waking up the communication unit from an idle mode to activate the receiver to receive the signal transmitted from the interrogator (col. 9, line 32-52, the beacon wherein the receiver located operates intermittently for receiving tracking signal).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 5, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isikoff in view of Heinrich et al. US 5,874,902.

Isikoff fails to disclose the anti-theft device having a fusible link. Heinrich in the same field of endeavor disclose the anti-theft device having a fusible link 113 (Fig. 12) for the purpose of keeping the anti-theft device in shut-off state until it is fused by the RF field.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a fusible link in the device of Isikoff as evidenced by Heinrich because Isikoff suggests the anti-theft device having shut-off unit and Heinrich in the same field of endeavor further teaches the anti-theft device including a fusible link for the purpose of keeping the anti-theft device in shut-off state until it is fused by the RF field.

3. Claim 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Isikoff in view of Sheffer (5515419).

Isikoff does not disclose the data stored in memory comprising purchase data or purchaser data. In an analogous art, Sheffer the vehicle sending owner's address and Vehicle ID (which must be stored in the memory associated with the vehicle) for the purpose of providing unique information representing different devices. See col. 8 lines 25-40. It is interpreted that the owner's address and VIN number are purchase and purchaser data as broadly claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to store purchase data or purchaser data in the device of Isikoff as evidenced by Sheffer because it would assist in associating a stolen vehicle with it's rightful owner.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Isikoff in view of Glenn US 5,406,261.

Isikoff does not disclose the detail of the blocking circuit. Glenn discloses the power control including transistor having a current path connected between the power source 22 of the electronic apparatus and utilization circuit (system board 20, floppy disk drive 24), and a control terminal supplied with the shut-off signal (control function) (Fig. 8b).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the transistor to the blocking circuit in the device of Isikoff as evidenced by Glenn because Isikoff suggest the anti-theft device having a blocking circuit to cut off the power supply and Glenn teaches in detail of the blocking circuit having a transistor wherein current path is connected between the power source of the

Art Unit: 2635

electronic apparatus and utilization circuit, and a control terminal supplied with the shut-off signal.

5. Claim 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isikoff in view of Glenn and further view of Heinrich et al.

Isikoff does not disclose the detail of the blocking circuit. Glenn discloses the power control including a first transistor and a second transistor having a current path connected between the power source 22 of the electronic apparatus and utilization circuit, and control terminal (Fig. 8c). Furthermore, Heinrich in the same field of endeavor disclose the anti-theft device having a fusible link 113 (Fig. 12) for the purpose of keeping the anti-theft device in shut-off state unit it is fused by the RF field. The claimed invention would be expected to perform equally well with two transistors shown in Fig. 8 of Glenn combined with a fuse of Heinrich. Both structure of blocking circuit of the claim and combined structure of blocking circuit of prior art accomplish the same result that is cutting off power by blocking the flow of electricity from the power source and utilization circuit while the control from CPU to utilization circuit is still maintained. The structure of blocking circuit having two transistors, a fuse, and a resistor appears to offer no advantage over the prior art's two transistors and a fuse; it makes no difference in performance which arrangement is employed.

Response to Arguments

Applicant's arguments filed 1/13/03 have been fully considered but they are not persuasive.

The applicant argues that the beacon of Isikoff is not separate from the utilization circuitry of the electronic apparatus. Isikoff does disclose that the beacon may be made as a removable assembly; this is interpreted that the beacon may be made separate from the utilization circuitry for normal operations of electronic apparatus it is attached to. Col. 4 lines 35-38. The applicant's arguments with respect to claims 5, 10 and 18 add nothing additional to the argument addressed above with respect to claims 1, 6 and 11.

6. The applicant argues, with respect to claims 19 and 20 that neither Glenn nor Heinrich disclose the power blocking circuit specified in claims 19 and 20. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the applicant argues that there is no suggestion to integrate a fuse into figure 8c of Glenn. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Art Unit: 2635

Then the applicant argues that there is no suggestion to integrate a fuse into the structure of claims 19 and 20. It is noted that the structure of claims 19 and 20 are directed to a disabling element (circuit). Heinrich uses a fuse to maintain disablement of the device once it is determined that a device should be disabled. Therefore, Heinrich does in fact suggest the use of a fuse in a disabling circuit to improve the disabling ability of the circuit.

Applicant's arguments with respect to claims 16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Brian A Zimmerman
Primary Examiner
Art Unit 2635

A handwritten signature in black ink, appearing to be 'B. Zimmerman', with a long horizontal stroke extending to the right.

BaZ
March 27, 2003